

REMARKS

The Office Action of August 25, 2005 was received and reviewed. Applicant would like to thank the Examiner for the consideration given to the above-identified application.

Reconsideration and withdrawal of the currently pending rejections are requested for the reasons advanced in detail below.

Claims 1-36 are pending for consideration, of which claims 1, 7, 13, 19, 25 and 31 are independent.

Referring now to the detailed Office Action, claims 1-36 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-27 of U.S. Patent No. 6,706,568. In response, Applicant respectfully requests that this double patenting rejection be held in abeyance until the claims are in condition for allowance.

Claims 1-36 stand rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. The Examiner asserted that independent claims 1, 7, 13, 19, 25 and 31 fail to recite the step of “forming an oxide film on a surface of the above semiconductor film” and therefore the claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In response, Applicant respectfully directs the Examiner’s attention to MPEP § 2164.08 (page 2100-197, Rev. 2, May 2004). It is stated therein that when analyzing the enabled scope of a claim, the teaching in the specification must not be ignored because claims are to be given their broadest reasonable interpretation that is consistent with the specification, and that claims are interpreted in light of the specification does not mean that everything in the specification must be read into the claims [emphasis added].

Further, the Examiner’s attention is directed to MPEP §2164.08(c), which is reads as follows:

2164.08(c) Critical Feature Not Claimed

A feature which is taught as critical in a specification and is not recited in the claims should result in a rejection of such claim under the enablement provision section of 35 U.S.C. 112. See In re Mayhew, 527 F.2d 1229, 1233, 188 USPQ 356, 358 (CCPA 1976). In determining whether an unclaimed feature is critical, the entire

disclosure must be considered. Features which are merely preferred are not to be considered critical. In re Goffe, 542 F.2d 564, 567, 191 USPQ 429, 431 (CCPA 1976).

Limiting an applicant to the preferred materials in the absence of limiting prior art would not serve the constitutional purpose of promoting the progress in the useful arts. Therefore, an enablement rejection based on the grounds that a disclosed critical limitation is missing from a claim should be made only when the language of the specification makes it clear that the limitation is critical for the invention to function as intended [emphasis added]. Broad language in the disclosure, including the abstract, omitting an allegedly critical feature, tends to rebut the argument of criticality.

Still further, Applicant respectfully directs the Examiner's attention to MPEP §2163.06(III), which states the claims as filed in the original specification are part of the disclosure and therefore, if an application as originally filed contains a claim disclosing material not disclosed in the remainder of the specification, the applicant may amend the specification to include the claimed subject matter. *In re Benno*, 768 F.2d 1340, 226 USPQ 683 (Fed. Cir. 1985).

The Examiner asserted that the feature of forming an oxide film over the conductor film, which is allegedly disclosed in every embodiment in the specification, needs to be claimed. In response, Applicant respectfully submits that there is no requirement to claim each and every disclosed features in the specification and that Applicant is entitled to claiming the broadest scope consistent with the specification, as noted in MPEP §2164.08 and §2164.08(c) summarized above.

The Examiner also cited a number of other similar examples in supporting the §112, first paragraph rejection. However, in the interest of keeping prosecution history compact, Applicant respectfully notes that §2164.08 and §2164.08(c) should be used as a guide to the rejection, that the §112, first paragraph rejection, is improper, and that Applicant will not repeat the same arguments to the same type of rejection that has already been addressed.

Claims 7-12 stand rejectable if claims 13-18 are found allowable. The Examiner asserted that claims 13-18 will be objected to under 37 C.F.R. 1.75 as being a substantial duplicate of claims 7-12. In response, Applicant submits that claims 7 and 13, for example, recite different features. For example, claim 7 recites "radiating the semiconductor film with

a second laser beam after radiating with the first laser beam under an atmosphere comprising one of hydrogen and an inert gas”, while claim 13 recites “radiating the semiconductor film with a third laser beam after radiating with the second laser beam under an atmosphere comprising one of hydrogen and an inert gas”. Applicant respectfully submits that the above-mentioned exemplary features of claims 7 and 13 are clearly different, and that the claims are not duplicate of one another as alleged by the Examiner.

Claims 1 and 5 stand rejected under 35 U.S.C. §102(e) as being anticipated by Nita et al. (U.S. Patent No. 6,304,329 – hereafter Nita). Further, claims 2, 3, 7-9, 11, 13-15, 17, 25-28 and 31-33 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Nitta and further in view of Mitnaga et al. (U.S. Patent No. 5,808,321 – hereafter Mitnaga). Still further, claims 4, 6, 10, 12, 16, 18-24, 29-30 and 34-36 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Nitta and in view of Mitnaga and further in view of Ouderkirk et al. (U.S. Patent No. 4,879,176 – hereafter Ouderkirk).

With respect to the rejection under 35 U.S.C. 102(e) and 103(a), Applicant notes that Nita is commonly cited in all of the substantive rejections. In the rejections, the Examiner alleged that 52, 53 and 54 of Nita are laser beams irradiating a semiconductor film. However, Applicant respectfully notes that features 52, 53 and 54 (such as shown in Fig. 12) of Nita are laser diodes that are provided in order to detect the angular velocity off the other object, and the laser diodes are utilized in a ring resonator in a gyro. Therefore, Nita does not disclose radiating the semiconductor film with laser beams as recited in Applicant’s claimed invention, which is directed to a method of manufacturing a semiconductor device wherein a semiconductor film is crystallized by laser radiation. Moreover, as Nita is related to a gyro having a plurality of laser diodes, Nita does not teach, disclose or suggest, for example, the steps of forming a semiconductor film over an insulating surface, radiating the semiconductor film with a first laser beam, etc, as recited in Applicant’s claims 1 and 5.

Further, with respect to the rejection of claims 1 and 5, the Examiner asserted that Nita describes a method for manufacturing a semiconductor device comprising forming a semiconductor film over an insulating surface. However, the text cited by the Examiner as support for his allegation is to form an insulating film on a laser, not on a semiconductor film.

Consequently, since each and every feature of the present claims is not taught (and is not inherent) in the teachings of Nita, as is required by MPEP Chapter 2131 in order to

establish anticipation, the rejection of claims 1 and 5, under 35 U.S.C. §102(e), as anticipated by Nitta is improper.

With respect to the §103(a) rejection of claims 2, 3, 7-9, 11, 13-15, 17, 25-28 and 31-33, the arguments set forth above with respect to claims 1 and 5 are also applicable.

With respect to claim 7, for example, wherein the Examiner relied on Mitnaga as teaching radiating the semiconductor film, Applicant respectfully asserts that the citation recited by the Examiner is relating to furnace anneal and not laser beam radiation as cited in Applicant's invention.

With respect to claim 31, the Examiner alleged that Nitta discloses crystallizing the semiconductor film by a heat treatment. However, no such disclosure can be found in Nitta. As the Examiner did not point out the specific text and/or drawing of Nitta for support of this allegation, Applicant respectfully requests the Examiner to provide concrete support for his allegation.

With respect to the rejection of claims 4, 6, 10, 12, 16, 18-24, 29-30 and 34-36 over Nitta, Mitnaga and Ouderkirk, the arguments set forth above with respect to Nitta and the §102(e) rejection are also applicable. Further, Applicant respectfully asserts that Ouderkirk teaches surface modification of semicrystalline polymers, which is a different field of endeavor and technique than the presently claimed invention and that of Nitta and Mitnaga. Hence, the combination of Ouderkirk is not proper.

The Examiner contended that Ouderkirk is in the same field of endeavor as the present invention without specific support. Hence, since Applicant respectfully differs in opinion and does not agree with the mere assertion made, the Examiner is requested to clarify his reasoning for asserting Ouderkirk is in the same field of endeavor.

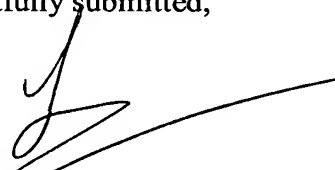
The requirements for establishing a *prima facie* case of obviousness, as detailed in MPEP § 2143 - 2143.03 (pages 2100-122 - 2100-136), are: first, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference to combine the teachings; second, there must be a reasonable expectation of success; and, finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. As Nitta, Mitnaga and Ouderkirk are deficient as noted above, their combination in the §103(a) rejections is improper and a *prima facie* case of obviousness has not been established.

With respect to the Examiner's statement: "the functional recitation 'wherein the radiating the semiconductor film with the first laser beam is held in order to form a crystallized semiconductor film' has not given patentable weight because it is narrative form", Applicant respectfully requests the Examiner to point to an authority or source for support of this statement with respect to claim 2, as well as with respect to other claims where this statement may have been also applied. Applicant respectfully submits that the above-mentioned claimed feature is a positive recitation of a step in a method, and that Applicant cannot make a connection between the claimed feature and the Examiner's recitation of §112, sixth paragraph, contending that the claimed feature bears no patentable weight because it is in narrative form.

As noted in MPEP §2181, which is directed to Identifying a 35 U.S.C. §112, Sixth Paragraph Limitation, "means-or-step-plus-function" is invoked by the usage of "means" or "step for", among others in a 3-prong analysis. However, the claim language of claim 2 has no such effect as to invoke §112, sixth paragraph. The Examiner is invited to conduct a conference with Applicant's representative to clarify his position that the claim language carries no patentable weight so that Applicant may prepare a proper response, as necessary.

In view of the foregoing, it is respectfully requested that the rejections and warning of record be reconsidered and withdrawn by the Examiner, that claims 1-36 be allowed and that the application be passed to issue. If a conference would expedite prosecution of the instant application, the Examiner is hereby invited to telephone the undersigned to arrange such a conference.

Respectfully submitted,



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